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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/849,570 | 05/20/2004 | Bobby L. Williamson | 005242.00132 | 6572 |

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| EXAMINER | |
|---|---|
| YAO, SAMCHUAN CUA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1733 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/849,570 | WILLIAMSON ET AL. | |
| | Examiner | Art Unit | |
| | Sam Chuan C. Yao | 1733 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *10 and 13-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittenmore (US 5,106,697) in view of Baxter (US 4,915,766) **or** vice versa for reasons of record set forth in a prior office action dated 09-25-06 in numbered paragraph 3, and for reasons set forth hereinafter.

As for an added limitation in claim 1, it is "preferred" in Baxter "to use an amount of acetone resin between about 10 to 50% by weight of the adhesive blend". This weight range clearly significantly overlaps the weight range recited in this claim. With respect to amended claim 11, "about 9% by weight" (emphasis added) is clearly close enough to an amount of "about 10%" (emphasis added) by weight, that one skilled in the art would have reasonably expected for them to achieve substantially the same desired reaction/curing characteristics. In fact, if about 9% and about 10% by weight are taken to embrace plus and minus 0.1 of 9% and 10% by weight, respectively, then the upper bound of the recited weight range overlaps with the lower bound of a weight range taught by Baxter. Equally important, while as has been noted above, it is preferred to use about 10-50% by weight of an acetone resin relative to an adhesive blend, there is clearly a

reasonable expectation of success for using an amount which is less than about 10% by weight (say about 9 wt% acetone-formaldehyde of the blend) as evidence from following passage "[w]hile there is wide latitude in the relative proportion of the phenolic resin-to-acetone resin, it is preferred ..." (emphasis added; col. 6 lines 10-17). Note: claim 1 in Baxter requires using "about 0.11" (emphasis added) by weight of acetone-formaldehyde per 1 by weight of phenol-formaldehyde. This weight ratio translates to **about** 9.9 by weight of acetone-formaldehyde per weight of an adhesive blend.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in number paragraph 2 as applied to claim 2 above, and optionally further in view of Detlefsen (US 5,057,591) for reasons of record set forth in a prior office action dated 09-25-06 in numbered paragraph 4.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 2 as applied to claim 1 above, and further in view of Walser (US 5,234,747) or Park et al (US 6,569,279) for reasons of record set forth in a prior office action dated 09-25-06 in numbered paragraph 5.

***Response to Arguments***

5. Applicant's arguments filed on 04-18-07 have been fully considered but they are not persuasive.

On page 8 full paragraph 1; Counsel has argued that, *"... there would have been no expectation that adhesive characteristics taught in Whittenmore and Baxter as being advantageous with respect to* ***plywood****, could successfully overcome the*

*art recognized difficulties associated with **LVL.**"* (bold-face added). It is respectfully submitted that, Counsel's argument is off-point. It is immaterial whether the collective teachings of prior art references would have suggested to one in the art of solving art recognized difficulties associated with LVL. What is essential in the issue of patentability under 35 U.S.C. 103(a) is "what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of the first one and then another of the isolated teachings in the art." In re Kuderna, 165 USPQ 575 (CCPA 1970). Moreover, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As for Counsel's argument regarding the amount of "a ketone-aldehyde cure promoter ... about 2% to about 15% by weight of the combined amount" of the adhesive blend, this weight range significantly overlaps with a with range of "about 10 to 50 of acetone-formaldehyde resin by wt% of the adhesive blend suggested by Baxter.

As for Counsel's argument on page 8 last full paragraph to page 9 regarding claim 11, as has been noted, "about 9% by weight" (emphasis added) is clearly close enough to an amount of "about 10%" (emphasis added) by weight, that one skilled in the art would have reasonably expected for them to achieve substantially the same desired reaction/curing chracteristics. In fact, if about 9%

and about 10% by weight are taken to embrace plus and minus 0.1 of 9% and 10% by weight, respectively, then the upper bound of the recited weight range overlaps with the lower bound of a weight range taught by Baxter. Equally important, while as has been noted above, it is preferred to use about 10-50% by weight of an acetone resin relative to an adhesive blend, there is clearly a reasonable expectation of success for using an amount which is less than about 10% by weight (say about 9 wt% acetone-formaldehyde of the blend) as evidence from following passage "[w]hile there is wide latitude in the relative proportion of the phenolic resin-to-acetone resin, it is preferred ..." (emphasis added; col. 6 lines 10-17). Note: claim 1 in Baxter requires using "about 0.11" (emphasis added) by weight of acetone-formaldehyde per 1 by weight of phenol-formaldehyde. This weight ratio translates to **about** 9.9 by weight of acetone-formaldehyde per weight of an adhesive blend.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
04-20-07